

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re application of:
Jacqueline Evynne Breuninger Buskop**

Group Art Unit: 3677

Serial Number: 10/675,515

Examiner: Reese, David C

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**For: ADVERTISING DEVICE FOR
PRODUCE AND CANDY VENDORS**

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RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

This brief is in response to the Notice of Non-Compliant Appeal Brief mailed September 26, 2008.

If an extension of time is required to enable this paper to be timely filed, this paper is to be construed as also constituting a Petition for Extension of Time under 37 CFR § 1.136(a) for a period of time sufficient to enable this document to be timely filed. Should any other fee be deemed necessary for any other reason relating to this document, the Commissioner is hereby authorized to deduct said fee from **Buskop Law Group Deposit P.C., Account No. 50-1313**.

This Supplemental Brief contains a replacement Section III, "Status of Claims," replacement Section VI, "Grounds for Rejection to be Reviewed on Appeal," and a replacement Section VII "Argument."

III. STATUS OF CLAIMS

Claims 1, 5, 7-9, and 13 remain pending in this application.

1. (Rejected and Objected to) An advertising apparatus for produce vendors consisting of a pair of earrings, wherein each earring consists of:
 - a. at least one earring clip with a back side and a front side for engaging a non-pierced ear;
 - b. at least one line axially secured to the at least one earring clip, a first hook axially secured to at least one line; a second hook axially secured to the at least one line between the earring clip and the first hook, wherein the second hook is axially aligned with the first hook, and wherein the first hook and the second hook each have at least a first prong and a second prong respectively, for engaging at least two different edible food items;
 - c. wherein the at least two different edible food items are removably secured to each hook by at least partially penetrating the at least two different edible food items using each hook, and the at least two different edible food items are selected from a member of the group consisting of: a fruit, a vegetable, and combinations thereof; and
 - d. an automatic LED disposed on a lower portion of the front side for lighting the at least two different edible food items, wherein the automatic LED is electrically insulated from the at least one earring clip, and wherein the automatic LED is a blinking LED light that can be actuated with a switch secured to the at least one earring clip illuminating the at least two different edible food items.
2. (Cancelled)
3. (Cancelled)
4. (Cancelled)

5. (Rejected) The advertising apparatus of claim 1, wherein the first hook and the second hook are each between 1.5 inches and 3 inches in overall length.
6. (Cancelled)
7. (Rejected) The advertising apparatus of claim 1, wherein the at least one edible food item is selected from a member of the group consisting of: blueberries, strawberries, dried fruits, blackberries, cherry tomatoes, kiwi fruits, other fruits, other vegetables, and combinations thereof.
8. (Rejected and Objected to) An advertising apparatus for candy vendors consisting of a pair of earrings, wherein each earring consists of:
 - a. at least one earring clip with a back side and a front side for engaging a non-pierced ear;
 - b. at least one line axially secured to the at least one earring clip; a first hook axially secured to the at least one line; a second hook axially secured to the at least one line between the at least one earring clip and the first hook, wherein the second hook is axially aligned with the first hook, and wherein the first hook and the second hook each have at least a first prong and a second prong respectively, for engaging at least two different chewy candy items;
 - c. wherein the at least two different chewy candy items are removably secured to each hook by at least partially penetrating the at least two different chewy candy items using each hook,; and
 - d. an automatic LED disposed on a lower portion of the front side for lighting the at least two different chewy candy items, wherein the automatic LED is electrically insulated from the at least one earring clip, and wherein the automatic LED is a blinking LED light that can be actuated with a switch secured to the at least one earring clip illuminating the at least two different chewy candy items.
9. (Rejected) The advertising apparatus of claim 8, wherein the at least one chewy candy item is selected from a member of the group consisting of: soft licorice, soft raspberries,

juicy fruits, and combinations thereof.

10. (Cancelled)
11. (Cancelled)
12. (Cancelled)
13. (Rejected) The advertising apparatus of claim 8, wherein the first hook and the second hook are each between 1.5 inches and 3 inches in overall length.
14. (Cancelled)

VI. GROUNDS FOR REJECTION TO BE REVIEWED ON APPEAL

Claims 1 and 8 are under appeal.

Claim 1: has been objected to; has been rejected under 35 USC §112 first paragraph; and has been rejected under 35 USC § 103(a) as being unpatentable over *Westmoland* (US 5,201,578), in view of *Bradley* (US 2,180,726), and in further view of case law.

Claim 5 has been rejected under 35 USC § 103(a) as being unpatentable over *Westmoland* (US 5,201,578), in view of *Bradley* (US 2,180,726), and in further view of case law.

Claim 7 has been rejected under 35 USC § 103(a) as being unpatentable over *Westmoland* (US 5,201,578), in view of *Bradley* (US 2,180,726), and in further view of case law.

Claim 8: has been objected to; has been rejected under 35 USC §112 first paragraph; and has been rejected under 35 USC § 103(a) as being unpatentable over *Westmoland* (US 5,201,578), in view of *Bradley* (US 2,180,726), in view of *Johnson* (US 6,619,816), and in even further view of case law.

Claim 9 has been rejected under 35 USC § 103(a) as being unpatentable over *Westmoland* (US 5,201,578), in view of *Bradley* (US 2,180,726), in view of *Johnson* (US 6,619,816), and in even further view of case law.

Claim 13 has been rejected under 35 USC § 103(a) as being unpatentable over *Westmoland* (US 5,201,578), in view of *Bradley* (US 2,180,726), in view of *Johnson* (US 6,619,816), and in even further view of case law.

VII. ARGUMENT

35 U.S.C. §112 REJECTIONS OF CLAIM 1 AND CLAIM 8

Appellant contends that the rejections of Claims 1 and 8 under 35 U.S.C. §112, first paragraph, should be reversed.

The recitation “a pair of earrings” is taught by Appellant’s disclosure

Appellant believes that the recitation, “a pair of earrings” is not new matter, as suggested by the Examiner.

Appellant believes that one skilled in the art of jewelry would understand Appellant’s disclosure to teach a pair of earrings, since earrings are conventionally worn as a pair. Additionally, Appellant references use of “earrings” in Paragraphs [0003] and [00018] of Appellant’s Specification, as filed.

A specification complies with the 35 USC §112, first paragraph, written description requirement if it conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, the inventor was in possession of the invention. *Ex parte Hans-Gerd Brunneke*, 2008-1120 (BPAI 6/10/2008) (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-65 (Fed. Cir. 1991).

Therefore, Appellant believes “a pair of earrings” does not constitute new matter, and Appellant’s initial disclosure reasonably conveys to one skilled in the relevant art that the present advertising device includes a “pair” of earrings.

The recitation that the automatic LED is “electrically insulated from the at least one earring clip” is taught by Appellant’s disclosure

Appellant believes that the recitation that the automatic LED is “electrically insulated from the at least one earring clip” is not new matter, as suggested by the Office Action.

Appellant’s Figure 2 depicts a LED light 16 secured to an earring clip 10. The earring

clip 10, hooks 12 and 15, prongs 22 and 24, and edible items 14, 14a, and 14b, as shown, do not form a complete circuit capable of conducting power to the LED light 16. (Appellant's Paragraph [00013] and Figure 2)

Therefore, Appellant's LED light 16 must inherently include circuitry that is insulated from the earring clip 10. Without such electrical insulation, the LED light 16 would be unable to operate as intended.

Information contained in any one of the specification, claims, or drawings of the application as filed may be added to any other part of the application without introducing new matter. MPEP §2163.06 and *Ex Parte Hans-Gerd Brunneke*, supra, page 5 (reversing a §112, first paragraph rejection due to the disclosure of a figure enabling a rejected claim).

There is no *in haec verba* requirement for supporting newly added claim limitations; newly added claim limitations may be supported in the specification through express, implicit, or inherent disclosure. MPEP §2163.

In *Brunneke*, the Board reversed a rejection of eight claims under 35 USC §112, first paragraph. The *Brunneke* Examiner argued that the appellant's original disclosure lacked descriptive support for "a duct extending from said electrode to outside of said bearing shell," noting that in the text of the disclosure, the duct was not in the bearing shell, but rather in a ball and socket joint housing. The appellant argued that Figure 1 of the disclosure showed a portion of the duct at issue outside of the bearing shell, even though the related paragraph in the specification did not specifically reference a duct. The Board determined that the appellant's original disclosure showed possession of the duct, as claimed, and reversed the rejection.

Applying *Brunneke* and MPEP §2163, Appellant believes that the disclosure of Figure 2 shows possession of the automatic LED, electrically insulated from the earring clip, as claimed, independent of whether the text describing Figure 2 recites this limitation *in haec verba*.

One skilled in the relevant art would reasonably construe, from the implicit and inherent disclosures of Figure 2 and Paragraph [00013], that the LED light is electrically insulated from the earring clip.

35 U.S.C. §103 REJECTIONS OF CLAIM 1 AND CLAIM 8

Appellant's 5 elements of Claim 1 and Claim 8 are not taught by the combination of *Westmoland, Bradley, and Johnson*

Appellant teaches an advertising device having two hooks, axially aligned with each other, that are axially secured to a line that is secured to an earring clip, each hook having prongs for engaging edible food items for illumination by an automatic LED. The automatic LED is electrically insulated from the earring clip.

Specifically, Appellant teaches:

- 1) a first hook and a second hook axially secured to at least one line;
- 2) the first hook and the second hook axially aligned with each other;
- 3) use of the first hook and second hook for penetrating at least two edible food items;
- 4) an automatic LED; and
- 5) the automatic LED is electrically insulated from the earring clip.

A. The Office Action states that *Westmoland* does not teach first and second hooks axially secured to at least one line, and axially aligned with each other

Westmoland does not teach first and second hooks axially secured to at least one line, and axially aligned with each other, each having a first prong and a second prong for engaging at least two different edible food items that are partially penetrated by each hook. (See Office Action, mailed 01/16/2008)

Without hooks, prongs, and lines, the jewelry described by *Westmoland* is not suitable for use as an advertising device that retains edible food items by penetrating the food items with

hooks. *Westmoland* describes purely ornamental jewelry, rather than an advertising device, as taught by Appellant.

B. *Westmoland* does not teach an automatic LED

Appellant's "automatic LED" is defined as:

"an LED light (16) secured to the earring clip that automatically lights up the hook (12) in dim light." (Appellant's Paragraph [00013])

Westmoland describes lighted or illuminated jewelry having "lighting elements 4," which can include LEDs. (*Westmoland*, Column 3, Lines 16-18) *Westmoland* does not teach an automatic LED.

In contrast, *Westmoland* describes insertion of a battery 3 between two plates 1, 2 to cause the lighting elements to be illuminated. (*Westmoland*, Column 4, Lines 55-66 and Column 5, Lines 15-36)

A finding of "obviousness requires a suggestion of all limitations in a claim," including Appellant's teaching of an automatic LED. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)); *In re Ochiai*, 71 F.3d 1456, 1572 (Fed. Cir. 1995).

Appellant's advertising device fore automatically conserves power in lighted conditions by remaining inactive, and can automatically illuminate attached edible food items in dim conditions, without requiring manipulation of switches or batteries, which can be tedious and difficult when an earring is being worn, and can generate additional expense.

C. *Westmoland* fails to teach that the LED is electrically insulated from the earring clip

Westmoland describes a jewelry item that "itself is part of an electrical circuit." (*Westmoland*, Column 1, Lines 5-8)

Westmoland teaches a lighting element having electrically conductive leads is connected to the jewelry body, which includes plate members spaced apart with electrically conductive means, and a battery sized to fit between the plate members. (*Westmoland*, Column 1, Lines 30-43) The assembly of the jewelry completes an electrical circuit. (*Westmoland*, Column 1, Lines 43-48) The plates of the jewelry body are formed from an electrically conductive material to which a battery and lighting elements are directly attached. (*Westmoland*, Column 3, Lines 27-35)

Westmoland does not teach a LED that is electrically insulated from the earring clip.

Appellant defines the term “earring clip”, depicted as element 10 in Appellant’s Figures 1 and 2, to include not only the front side 13 and back side 11 that secure the advertising device to the ear, but also the earring body. (Appellant’s Paragraph [00011] and Figures 1 and 2)

The “earring clip,” as defined by Appellant, applied to the jewelry of *Westmoland*, would include not only the spring earring clip attachment 10, but also the plates 1, 2, and the battery 3, which form the earring body.

In contrast, the plates of *Westmoland* are specifically intended to function as conductors for power between the battery and the LED, while Appellant’s earring clip 10 is instead insulated from the automatic LED.

In *Ex parte Boyd Clark Wade and Jimmy H. Torbett*, 2008-1120 (BPAI 6/25/2008), the Board reversed the final rejection of seven claims, the issue turning on the definition of the term “survey rod.” The *Wade* Examiner construed the term “survey rod” to be a thin straight piece or bar of material of a size and shape that would facilitate surveying. The appellants contended that those skilled in the art would define the term “survey rod” differently, in light of the specification.

The Board stated that the scope of the claims in patent applications is not determined solely on the basis of claim language, but upon giving claims “their broadest reasonable interpretation *consistent with the specification*” and “in light of the specification as it would be interpreted by *one of ordinary skill in the art*.” *Id* (citing *In re Am. Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). Based on the disclosure of the appellants’ specification, the

Board held that the specification clearly defined the survey rod in such a manner that those skilled in the art would understand the survey rod as described by the appellants in their brief.

The specification is the “single best guide” to claim construction, and the construction of claims must be construed from the viewpoint of one having ordinary skill in the art “on a reading of the patent documents,” including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (reaffirming *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) and *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996)).

Applying both *Wade* and *Phillips* to the instant application, Appellant’s Paragraph [00011] and Figures 1 and 2, define “earring clip” to include the entire depicted part labeled as element 10, namely the front side 13, back side 11, and structure of the earring body.

As such, Appellant’s limitation “wherein the automatic LED is electrically insulated from the earring clip” includes that the automatic LED is electrically insulated from the entirety of the earring clip 10.

Westmoland fails to teach an “earring clip,” as the structure of the earring body, that is electrically insulated from the automatic LED.

D. *Bradley* does not add the elements of Claim 1 and Claim 8 not taught by *Westmoland*

Appellant teaches a first hook 12 and a second hook 24, axially aligned with a line 19. (Appellant’s Figure 3 and Paragraph [00018])

Appellant uses the term “axially” with its common meaning to one skilled in the art: “Relating to, characterized by, or forming an axis.” (See e.g. <http://www.thefreedictionary.com/axially>)

Bradley describes attaching a clip 11 perpendicularly, rather than axially, to a link of chain 10 using a bifurcated element 15, having an aperture 14 through which the link of chain can extend, similar to hanging a charm from a necklace or bracelet. (*Bradley*, Column 2, Lines 27-32)

Conversely, Appellant's line, first hook, and second hook are characterized by and define a vertical axis, along which the line, first hook, and second hook are positioned.

The jaws described by *Bradley*, which the Examiner interprets as hooks, are not axially aligned with the chain, which the Examiner interprets as a line, but instead hang perpendicularly from the chain. (*Bradley*, Column 2, Lines 27-32 and Figure 1)

Bradley describes two jaws, faced in opposition, rather than in axial alignment, like a clamp, operating similar to a pair of tongs to secure objects between piercing points.

The clip 11 described by *Bradley* includes two jaws 16, 17, which pivot about a pin 21, allowing the piercing points 22a of the jaws to be manually opened, while a coiled spring 23 retains the jaws in a closed position, similar in operation to a clamp or pair of tongs. (*Bradley*, Column 2, Lines 32-51 and Figures 2 and 3)

Appellant's arrangement of axially aligned hooks enables multiple edible food items to be displayed vertically, while providing a predictable distribution of weight directly beneath the earring clip. *Bradley*'s use of jaws and clips that are not axially aligned with the line or with one another is not suitable for retaining and displaying items having differing weights, which could cause an earring to become disengaged from the ear or to hang in an uncomfortable or aesthetically unappealing, lopsided manner.

Additionally, Appellant's axial arrangement of hooks enables Appellant's advertising device to secure one or more edible food items with a single hook, by penetrating the edible food items with prongs, while the jewelry described by *Bradley* uses two opposing jaws to grasp and retain objects in a desired position.

In *Ex parte Walker et al.*, 2007-4170 (BPAI 05/21/2008), the Board reversed a final rejection of forty claims. The cited reference disclosed a video poker machine with a selector button allowing the player to select from different payout tables at any time. The appellant argued that the cited reference, while allowing the player to select payout tables, did not teach

appellant's step of making a determination whether to offer the player a choice to switch payout tables, and simply offered the option at any time during play through the existence of the selector button.

Although the cited reference ostensibly accomplished the same result as the application at issue, it did so in a functionally different manner. As such, the Board held that the cited reference did not anticipate the claims at issue.

Applying *Walker* to the instant application, Appellant believes that the Examiner's interpretation of the clip described by *Bradley* as a hook is improper.

While the jaws described by *Bradley* have a curved shape and secure objects between piercing points, the jaws function using a coiled spring to retain two opposing jaws in a closed position on opposite sides of an object. Appellant's hooks function in a different manner, by penetrating edible food items with single prongs, thereby retaining the items in the manner of a hook, rather than a clip.

In light of *Walker*, Appellant believes that *Bradley* fails to teach use of hooks to secure edible food items, as taught by Appellant.

Also, *Bradley* does not teach use of any illuminating devices and instead describes only ornamental jewelry, without reference to such features.

Appellant's automatic LED enables Appellant's advertising device to illuminate and attract attention to displayed edible food items, thereby enabling Appellant's earrings to be useable as an advertising device, and not merely ornamental jewelry.

E. *Johnson* was cited to show use of candy with lighting elements and does not teach the elements of Claim 8 not taught by *Westmoland* and *Bradley*

Johnson describes a confection assembly, namely a lighted lollipop or similar candy item, having a light device, a light transmission element attached to the light device, and an edible confection attached to the light transmission element. (*Johnson*, Column 2, Lines 18-20)

Johnson does not teach use of hooks to secure the confection, but instead teaches a mounting hole 26 in the confection. (*Johnson*, Column 4, Lines 34-38 and Column 2, Lines 20-23)

Johnson thereby fails to teach use of first and second axially aligned hooks that are axially secured to at least one line, as taught by Appellant.

Also, although *Johnson* describes that the light device 16 can be configured to use standard incandescent bulbs, LEDs, or other suitable light generating mechanisms 22 (*Johnson*, Column 4, Lines 1-3), *Johnson* does not teach an automatic LED that “automatically lights up the hook (12) in dim light,” as taught by Appellant. (Appellant’s Paragraph [00013])

Johnson also does not teach an automatic LED light that is electrically insulated from an earring clip, as *Johnson* does not teach an earring clip or other comparable structure.

Johnson thereby fails to teach an automatic LED that is electrically insulated from an earring clip, as taught by Appellant.

The combination of useful elements for the novel marketing device of this now 11-year-old Applicant has not been taught by the references. She has had financial success in the marketplace with the present device, and desperately needs a patent issued to develop her business. Please help her!

For the reasons stated above, Appellant believes that the recitations “a pair of earrings” and “wherein the automatic LED is electrically insulated from the earring clip” do not constitute new matter, and the rejections under 35 USC §112, first paragraph, should be reversed.

Additionally, the rejections under 35 USC §103 should be reversed, as the combination of *Westmoland*, *Bradley*, and *Johnson* fails to teach:

- 1) a first hook and a second hook axially secured to at least one line;
- 2) the first hook and the second hook axially aligned with each other;
- 3) use of the first hook and second hook for penetrating at least two edible food items;
- 4) an automatic LED; and
- 5) the automatic LED is electrically insulated from the earring clip;

In view of the foregoing, it is respectfully submitted that the Examiner erred in not allowing all claims pending in the present application over the prior art of record. The undersigned attorney may be contacted at (713) 275-3400 with respect to any questions, comments, or suggestions in relation to this appeal.

Respectfully submitted,



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